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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,918	01/26/2005	Dieter Sauter	103196-00006	8417

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EXAMINER

HAUPT, KRISTY A

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/500,918

Applicant(s)

SAUTER ET AL.

Examiner

Kristy A. Haupt

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-19 is/are rejected.
- 7) ☒ Claim(s) 7 and 20-21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/04 and 2/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statements filed July 8, 2004 and February 8, 2005 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 102

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

1. Claims 1, 8-9 and 15 are rejected under 35 U.S.C. 102(a) as being anticipated by Beghello et al. US 2002/0114931 A1.

Beghello teaches:

With respect to claim 1, a value or security document:

- Said value or security document includes a circuit (Abstract and Page 2, Paragraph 0019)
- Said circuit is provided with a break adapted to be closed by a conducting element (Page 2, Paragraphs 0023 and 0027)

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With respect to claim 8 and incorporating all arguments of claim 1:

- Wherein a security feature is activatable by closing the break with the conducting element (Page 2, Paragraphs 0025 and 0027)

With respect to claim 9 and incorporating all arguments of claim 8:

- Wherein said security feature is realized by a component designed to issue a visual and/or audible and/or electromagnetic signal (Page 2, Paragraph 0025)

With respect to claim 15 and incorporating all arguments of claim 1:

- With a substrate made of paper and/or plastics film (Page 2, Paragraph 0028)

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2-7, 10-14 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beghello et al. US 2002/0114931 A1 in view of Johnson US 5,597,183.

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Beghello additionally teaches:

With respect to claim 6 and incorporating all arguments of claims 1-5:

- Wherein said break is constructed to be closable by an external conducting element

With respect to claim 7 and incorporating all arguments of claim 6:

- Wherein the external conducting element is a coin (Although Beghello fails to explicitly teach that a coin is used as the conducting element, it would have been obvious that any metal material could be used as they are conductors, therefore using a coin, which is a common metal material easily found on a user would be an obvious choice to complete the circuit)

With respect to claim 10 and incorporating all arguments of claims 1-5, 8 and 9:

- Wherein provision is made for a protective coat on at least one section of the circuit, said protective coat having an aperture in the region of the break so that the break is exposed (Page 2, Paragraph 0028 teaches a thread in the paper, which acts as a protective coat, and exposed on the surface of the note by contact points (Page 2, Paragraph 0021))

With respect to claim 12 and incorporating all arguments of claim 11:

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- Wherein said break is designed in such manner that the security feature is activated by closing the break with the conducting element (Page 2, Paragraphs 0023 and 0027)

With respect to claim 18 and incorporating all arguments of claim 17:

- Applying a protective coat to at least one section of the circuit, said coat having apertures in the region of the break causing the break to be exposed (Page 2, Paragraph 0028 teaches a thread in the paper, which acts as a protective coat, and exposed on the surface of the note by contact points (Page 2, Paragraph 0021))

Beghello fails to teach:

With respect to claim 2:

- Wherein said conducting element is situated on the document and said conducting element is movable across the break by forming the document

With respect to claim 3:

- Wherein said document forming operation involves a kinking, bending, rolling and/or folding process

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With respect to claim 4:

- Wherein said value or security document has a predetermined kinking, bending and/or folding line or a kinking, bending and/or folding zone along which the forming operation essentially takes place

With respect to claim 5:

- Wherein said predetermined kinking, bending and/or folding line or kinking, bending and/or folding zone is constructed in such manner that the forming operation is essentially reversible

With respect to claim 7:

- Wherein the external conducting element is a coin

With respect to claim 11:

- A source of supply wherein said source of supply is a battery and/or a solar cell and/or an antenna

With respect to claim 13:

- A first circuit pattern and a second circuit pattern which are separated from one another by the break and superimposable one upon the other by forming of the document so that the break is closed

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With respect to claim 14:

- Wherein said first circuit pattern and said second circuit pattern result in a coil subsequent to the document forming operation

With respect to claim 16:

- Wherein one or several elements of the circuit, in particular the conducting element, are printed onto the document by means of a printing ink

With respect to claim 17:

- Providing a substrate
- Printing a circuit onto said substrate, said circuit having a break and said break being closable by a conducting element

With respect to claim 19:

- Printing a first circuit pattern and a second circuit pattern which are separated from one another by the break so that by forming of the document the first circuit pattern and the second circuit pattern are superimposable one upon the other

However, Johnson teaches:

With respect to claim 2 and incorporating all arguments of claim 1:

- Wherein said conducting element is situated on the document and said conducting element is movable across the break by forming the document (Column 1, Lines 61-65)

With respect to claim 3 and incorporating all arguments of claim 2:

- Wherein said document forming operation involves a kinking, bending, rolling and/or folding process (Column 1, Lines 61-65)

With respect to claim 4 and incorporating all arguments of claim 3:

- Wherein said value or security document has a predetermined kinking, bending and/or folding line or a kinking, bending and/or folding zone along which the forming operation essentially takes place (Column 1, Lines 61-65 and Figure 1, #46)

With respect to claim 5 and incorporating all arguments of claim 4:

- Wherein said predetermined kinking, bending and/or folding line or kinking, bending and/or folding zone is constructed in such manner that the forming operation is essentially reversible (Abstract teaches the user can activate the switches as desired, it is inherent that once the user stops

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depressing the switch the switch will return to its normal state, thereby making it reversible)

With respect to claim 11 and incorporating all arguments of claim 1:

- A source of supply wherein said source of supply is a battery and/or a solar cell and/or an antenna (Column 4, Lines 6-8)

With respect to claim 13 and incorporating all arguments of claim 1:

- A first circuit pattern and a second circuit pattern which are separated from one another by the break and superimposable one upon the other by forming of the document so that the break is closed (Column 5, Lines 9-27)

With respect to claim 14 and incorporating all arguments of claim 13:

- Wherein said first circuit pattern and said second circuit pattern result in a coil subsequent to the document forming operation (Column 5, Lines 9-27)

With respect to claim 16 and incorporating all arguments of claim 15:

- Wherein one or several elements of the circuit, in particular the conducting element, are printed onto the document by means of a printing ink (Column 5, lines 9-27)

With respect to claim 17:

- Providing a substrate (Column 5, Lines 9-27)
- Printing a circuit onto said substrate, said circuit having a break and said break being closable by a conducting element (Column 5, Lines 9-27)

With respect to claim 19 and incorporating all arguments of claims 17 or 18:

- Printing a first circuit pattern and a second circuit pattern which are separated from one another by the break so that by forming of the document the first circuit pattern and the second circuit pattern are superimposable one upon the other (Column 5, Lines 9-27)

Allowable Subject Matter

4. Claims 20 and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. The following is an examiner's statement of reasons for allowance:

With respect to claim 20 and all its dependencies:

- A method of manufacturing a value or security document comprising the steps of printing a circuit onto a substrate by printing a first circuit pattern of a first coil winding half and printing a second circuit pattern that is a second coil winding half wherein the circuit patterns are separated from one another by the break so they are superimposable one upon the other

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by forming of the document and wherein a layer of insulating printing ink is printed over a region of the coil winding halves, the circuit having a break that is closable by a conducting element and applying a protective coat to at least one section of the circuit, the coat having apertures in the region of the break that causes the break to be exposed

The prior art of record fails to provide sufficient teaching or motivation to one of ordinary skill in the art to provide the additionally recited features of these claims in the combinations as claimed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Prior Art

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Lehureau et al. US 5,566,982 teaches bending a card to activate a security feature wherein the security feature allows a part of the card to light up

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristy A. Haupt whose telephone number is (571) 272-8545. The examiner can normally be reached on M-F 7:00-3:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

4/13/06

KAH

Katt



THIEN M. LE
PRIMARY EXAMINER